



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/879,070	06/19/97	JOHNSON	J 7789.130US01

LM21/1110

MERCHANT GOULD SMITH & EDELL
WELTER & SCHMIDT
3100 NORWEST CENTER
90 SOUTH SEVENTH ST
MINNEAPOLIS MN 55402-4131

EXAMINER
CIVAN, E

ART UNIT	PAPER NUMBER
2781	3

DATE MAILED:

11/10/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/879,070

Applicant(s)
Johnson et al.

Examiner
Ethan Civan

Group Art Unit
2761



☒ Responsive to communication(s) filed on Jun 19, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2761

DETAILED ACTION

IMPORTANT NOTICE

1. **Effective November 16, 1997, the Examiner Handling this application will be assigned to a new Art Unit as a result of the consolidation into Technology Center 2700. See the forthcoming Official Gazette notice dated November 11, 1997. For any written or facsimile communication submitted ON OR AFTER November 16, 1997, this Examiner, who was assigned to Art Unit 2411, will be assigned to Art Unit 2761. Please include the new Art Unit in the caption or heading of any communication submitted after the November 16, 1997, date. Your cooperation in this matter will assist in the timely processing of the submission and is appreciated by the Office.**

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claims 1 through 7 and 10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled

Art Unit: 2761

in the art to which it pertains, or with which it is most nearly connected, to make the invention. Lines 20 through 23 of claim 1 recite identifying the products most closely corresponding to a configured product. The specification does not describe how to determine what products most closely correspond to other products. As an example, in the personal computer industry there are many independent product configuration decisions. The speed of the microprocessor, the amount of random access memory, the size and number of hard drives, the model of video card, the type of speakers, the size of the display, the speed of the CD-ROM drive and other factors are all largely independent and each provides many options. The specification does not explain how the method would determine which of many similar systems would most closely correspond to an unavailable system entered by a user. Are certain factors (such as microprocessor model) more important than others (such as amount of memory) or are similarly priced systems the “most closely corresponding” or are systems specifically designed for certain classes of users (e.g., first time buyers, gamers, small office/home office users, and corporate users)? Are the rules for determining the “most closely corresponding” system generalized or are they applicable to comparisons between particular systems only? Are the rules based on the largest number of identical elements? Or are the rules to be determined by purchasers of the system and to be entered into a database directly or by means of a custom interface? One of ordinary skill in the art would not be able to build the claimed invention from the specification.

Claim 10 contains similar language and is rejected for the same reasons. Claims 2 through 7 depend on claim 1 and are accordingly rejected.

Art Unit: 2761

With respect to claim 10, lines 1 through 6 of page 36 recite identifying products from inventory most closely matching a customer's intended use of a product. The specification does not disclose how to identify which of a multitude of possible configurations of products would most closely match one of a multitude of possible intended uses of the product. One of ordinary skill in the art would be unable to determine from the specification how so to identify a matching product.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 through 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dworkin in view of Gupta and further in view of Winning Technologies.

With respect to claim 1, Dworkin discloses

A computer system implemented method for facilitating a sale of a product from an inventory of a selling entity, the computer system including a memory arrangement and at least one processing unit coupled to the memory arrangement; column 3, lines 48 through 64; the method comprising the steps of:

Art Unit: 2761

storing in the memory arrangement product inventory information related to the inventory of the selling entity; column 3, lines 60 through 66 and column 7, lines 54 through 61;

obtaining information regarding a customer's needs related to the selling entity products; column 5, lines 43 through 68; and

identifying from the inventory of the selling entity, using the stored inventory information, one or more products which most closely correspond to the configured product; column 6, lines 11 through 15.

Dworkin does not, but Gupta does, disclose

storing in the memory arrangement configuration information related to selling entity products offered for sale by the selling entity; column 5, lines 52 through 62; and

interactively selecting product options to define a configured product which satisfies the customer's needs using the stored configuration information to constrain selection of the product options; column 1, line 63 through column 2, line 3.

Combining the above features of Dworkin and Gupta would yield a product that would allow customers both to construct custom products, as in Gupta, and to search for products matching or almost matching their specifications, with a view to finding an attractive price on a product available in inventory, as in Dworkin. It would have been obvious to one of ordinary skill in the art at the time so to combine Dworkin and Gupta in view of the Selling Chain system disclosed in Winning Technologies, which sets forth these features, and provides an illustration in the automobile sales industry.

Art Unit: 2761

With respect to claim 2, Dworkin does not disclose
a method as recited in claim 1, further comprising ranking the selected product options according to a value of the product options to the customer and, using the ranking to identify products in inventory corresponding to the configured product.

However, Dworkin does reveal accepting desired specifications from a user in a variety of ways, not all of which are disclosed in the patent. Column 5, lines 55 through 68. It was well known in the art at the time to rank the relative importance of options or attributes to customers. It would have been obvious to one of ordinary skill in the art at the time to allow the user of a combined Dworkin/Gupta system, as discussed above in connection with claim 1, to rank the relative importance of various options of a custom configured system to him and to identify products meeting the highest ranked requirements.

With respect to claim 3, Dworkin does not, but Gupta does, disclose
a method as recited in claim 1, wherein the stored configuration information comprises a plurality of configuration rules which define relationships between two of more product options; column 5, line 52 through column 6, line 31.

Combining Dworkin with Gupta would yield a product that would allow customers both to construct custom products, as in Gupta, and to search for products matching or almost matching their specifications, with a view to finding an attractive price on a product available in inventory, as in Dworkin. It would have been obvious to one of ordinary skill in the art at the time so to combine Dworkin and Gupta in view of the Selling Chain system disclosed in Winning

Art Unit: 2761

Technologies, which sets forth these features, and provides an illustration in the automobile sales industry.

With respect to claim 4, Dworkin does not, but Gupta does, disclose
a method as recited in claim 3, wherein the configuration rules comprises a plurality of
logic rules; column 6, lines 21 through 30.

Combining Dworkin with Gupta would yield a product that would allow customers both
to construct custom products, as in Gupta, and to search for products matching or almost
matching their specifications, with a view to finding an attractive price on a product available in
inventory, as in Dworkin. It would have been obvious to one of ordinary skill in the art at the
time so to combine Dworkin and Gupta in view of the Selling Chain system disclosed in Winning
Technologies, which sets forth these features, and provides an illustration in the automobile sales
industry.

With respect to claim 5, Dworkin does not, but Gupta does, disclose

A method as recited in claim 3, wherein the configuration rules comprise constraint rules
which define engineering relationships between product options; column 6, lines 21 through 30.

Combining Dworkin with Gupta would yield a product that would allow customers both
to construct custom products, as in Gupta, and to search for products matching or almost
matching their specifications, with a view to finding an attractive price on a product available in
inventory, as in Dworkin. It would have been obvious to one of ordinary skill in the art at the
time so to combine Dworkin and Gupta in view of the Selling Chain system disclosed in Winning

Art Unit: 2761

Technologies, which sets forth these features, and provides an illustration in the automobile sales industry.

With respect to claim 6, Dworkin does not, but Gupta does, disclose
a method as recited in claim 3, wherein the configuration rules comprise resource rules which define relationships between product options in terms of resources used and resources required; column 6, lines 21 through 30.

Combining Dworkin with Gupta would yield a product that would allow customers both to construct custom products, as in Gupta, and to search for products matching or almost matching their specifications, with a view to finding an attractive price on a product available in inventory, as in Dworkin. It would have been obvious to one of ordinary skill in the art at the time so to combine Dworkin and Gupta in view of the Selling Chain system disclosed in Winning Technologies, which sets forth these features, and provides an illustration in the automobile sales industry.

With respect to claim 7, Dworkin does not, but Gupta does, disclose
a method as recited in claim 3, wherein the configuration rules comprise cross-reference rules which define relationships between similar product options; column 6, lines 21 through 30.

Combining Dworkin with Gupta would yield a product that would allow customers both to construct custom products, as in Gupta, and to search for products matching or almost matching their specifications, with a view to finding an attractive price on a product available in inventory, as in Dworkin. It would have been obvious to one of ordinary skill in the art at the

Art Unit: 2761

time so to combine Dworkin and Gupta in view of the Selling Chain system disclosed in Winning Technologies, which sets forth these features, and provides an illustration in the automobile sales industry.

With respect to claim 8, Dworkin discloses

a computer system implemented method for facilitating a sale of a product from an inventory of a selling entity, the computer system including a memory arrangement and at least one processing unit coupled to the memory arrangement; column 3, lines 48 through 64; the method comprising the steps of:

storing in the memory arrangement product inventory information related to the inventory of the selling entity; column 3, lines 60 through 66 and column 7, lines 54 through 61; and

obtaining information regarding a customer's needs related to the selling entity products; column 5, lines 43 through 68.

Dworkin does not, but Gupta does, disclose

storing in the memory arrangement configuration information related to selling entity products offered for sale by the selling entity; column 5, lines 52 through 62.

Neither Dworkin nor Gupta explicitly discloses

interactively selecting product options to define a sellable product which satisfies the customer's needs using the stored configuration rules and the stored product inventory information to constrain selection of the product options to product options available in the inventory of the selling entity.

Art Unit: 2761

However, Gupta discloses interactively selecting product options to define a sellable product which satisfies the customer's needs using the stored configuration rules and the stored product inventory information. Gupta further discloses the ability to remove unavailable parts from the parts catalog being used to define the sellable product (while possibly maintaining all parts in a different catalog not being used at the time), column 5, line 52 through column 6, line 30 and column 7, line 58 through column 8, line 62. It would have been obvious to one of ordinary skill in the art at the time to constrain selection of the product options to product options available in the inventory of the selling entity by removing unavailable parts from the parts catalog being used because it was well known in the art at the time to build products from only those parts available at the time.

Combining the above features of Dworkin and Gupta would yield a product that would allow customers both to construct custom products, as in Gupta, and to search for products matching or almost matching their specifications, with a view to finding an attractive price on a product available in inventory, as in Dworkin. It would have been obvious to one of ordinary skill in the art at the time so to combine Dworkin and Gupta in view of the Selling Chain system disclosed in Winning Technologies, which sets forth these features, and provides an illustration in the automobile sales industry.

With respect to claim 9, Dworkin discloses

a computer system implemented method for facilitating a sale of a product from an inventory of a selling entity, the computer system including a memory arrangement and at least

Art Unit: 2761

one processing unit coupled to the memory arrangement; column 3, lines 48 through 64; the method comprising the steps of:

storing in the memory arrangement product inventory information related to the inventory of the selling entity; column 3, lines 60 through 66 and column 7, lines 54 through 61;

obtaining information regarding a customer's needs related to the selling entity products; column 5, lines 43 through 68; and

providing an indication to the user of the computer system, based on the stored inventory information, of whether selection of the a particular presented product option, if incorporated into the configured product, would preclude obtaining the product from the inventory of the selling entity; column 6, lines 11 through 15.

Dworkin does not, but Gupta does, disclose

storing in the memory arrangement configuration information related to selling entity products offered for sale by the selling entity; column 5, lines 52 through 62; and

presenting product options to a user of the computer system for selection by the user to define a configured product which satisfies the customer's needs using the stored configuration information to constrain selection of the product options; column 1, line 63 through column 2, line 3.

Combining the above features of Dworkin and Gupta would yield a product that would allow customers both to construct custom products, as in Gupta, and to search for products matching or almost matching their specifications, with a view to finding an attractive price on a

Art Unit: 2761

product available in inventory, as in Dworkin. It would have been obvious to one of ordinary skill in the art at the time so to combine Dworkin and Gupta in view of the Selling Chain system disclosed in Winning Technologies, which sets forth these features, and provides an illustration in the automobile sales industry.

With respect to claim 10, Dworkin discloses

a computer system implemented method for facilitating a sale of a product from an inventory of a selling entity, the computer system including a memory arrangement and at least one processing unit coupled to the memory arrangement; column 3, lines 48 through 64; the method comprising the steps of:

storing in the memory arrangement product inventory information related to the inventory of the selling entity; column 3, lines 60 through 66 and column 7, lines 54 through 61.

Dworkin does not, but Gupta does, disclose

storing in the memory arrangement configuration information related to selling entity products offered for sale by the selling entity; column 5, lines 52 through 62.

Neither Dworkin nor Gupta explicitly discloses

obtaining information regarding a customer's intended uses of a product to be purchased; assigning a corresponding value to each of the customer's uses depending on an importance of the use to the customer; and

identifying, using the stored inventory information and the obtained information regarding the customer's intended uses and corresponding value, one or more products which are in the

Art Unit: 2761

inventory of the selling entity and which most closely satisfy the customer's intended use of the product.

However, Dworkin discloses obtaining information regarding a customer's need in terms of minimum specifications of a product, column 5, lines 43 through 68. It was well known in the art at the time to gather minimum specifications by asking questions regarding intended use, in lieu of asking questions regarding technical specifications, particularly in the case of a less sophisticated customer (e.g., asking the customer whether a printer was to be used as a high capacity printer for business purposes or as a low capacity printer for home purposes in lieu of asking whether a laser or ink jet printer was desired).

It was well known in the art at the time to assign a value to each factor or feature of a configuration depending on the importance of the factor or feature to the customer. It would have been obvious to one of ordinary skill in the art at the time to assign such a value to each intended use when soliciting requirements in the form of intended uses so as to be able to determine the most important requirements of the customer.

Dworkin discloses using a set of specifications to identify products available in inventory. Column 6, lines 11 through 15. Once the most important specifications or features had been identified as described in the preceding paragraphs, it would have been obvious to one of ordinary skill in the art at the time to use those specifications to identify products available in inventory because otherwise gathering the specifications would have been pointless. It would further have been obvious to one of ordinary skill in the art at the time to rank the identified products based on

Art Unit: 2761

the degree to which each corresponded to the customer's highest ranked intended uses of the product because doing so would allow a less technically sophisticated customer to select the most useful product without understanding the relative importance of all of the product configuration options.

Combining Dworkin with Gupta would yield a product that would allow customers both to construct custom products, as in Gupta, and to search for products matching or almost matching their specifications, with a view to finding an attractive price on a product available in inventory, as in Dworkin. It would have been obvious to one of ordinary skill in the art at the time so to combine Dworkin and Gupta in view of the Selling Chain system disclosed in Winning Technologies, which sets forth these features, and provides an illustration in the automobile sales industry.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - a. U.S. Patent Number 4,887,208 discloses a sales and inventory control system.
 - b. U.S. Patent Number 4,972,318 discloses an inventory control system.
 - c. U.S. Patent Number 5,515,524 discloses a configuration system.
 - d. U.S. Patent Number 5,708,798 discloses a configuration system.

Art Unit: 2761

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan D. Civan whose telephone number is (703) 308-5875. The examiner can normally be reached on Monday through Thursday from 8:30 a.m. to 6:00 p.m. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emanuel Todd Voeltz, can be reached at (703) 305-9714. The fax number for the organization where this application or proceeding is assigned is (703) 308-5357.

Application/Control Number: 08/879070

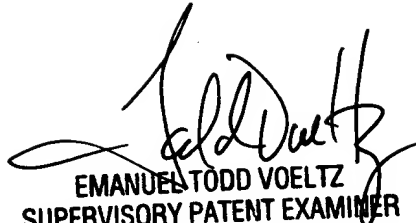
Page 16

Art Unit: 2761



EDC

November 9, 1998



EMANUEL TODD VOELTZ
SUPERVISORY PATENT EXAMINER
GROUP 2700